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09/855,281	05/15/2001	Takenori Kohda	JP920000095	1913

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EXAMINER

BATURAY, ALICIA

ART UNIT PAPER NUMBER

2155

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,281

Applicant(s)

KOHDA ET AL.

Examiner

Alicia Baturay

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. This Office Action is in response to the amendment filed 14 June 2005.
2. Claims 1-22 were amended.
3. Claims 1-22 are pending in this Office Action.

Response to Amendment

4. The rejection of claims 1-4 under 35 U.S.C. § 101 was addressed and is withdrawn.
5. The rejection of claims 9-11, 16-17, and 20-22 under 35 U.S.C. 101 regarding reciting non-statutory subject matter was addressed and is withdrawn. However, the amendments presented necessitated new grounds of 35 U.S.C. 101 rejections, which are outlined below.
6. Applicant's amendments and arguments with respect to claims 1-22 filed on 14 June 2005 have been fully considered but they are deemed to be moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 9-11, 16-17, and 20-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

9. With respect to claims 9-11, the claimed invention is directed to non-statutory subject matter. The claims recite "...a server comprising" which is essentially software per se. While claim 9 recites "the server comprising," there is nothing in claims 9-11 that explicitly indicates a computer performing any of the steps.

10. With respect to claims 16 and 17, the claimed invention is directed to non-statutory subject matter. The claims recite "...an object control system of a computer" which is essentially software per se. While claim 16 recites an object control system "of a computer," there is nothing in claims 16 or 17 that explicitly indicates a computer performing any of the steps.

11. With respect to claim 20, the language of the claim appears to be drawn to non-functional descriptive material. An "object" as recited in claim 20 is data, per se, lacking any functionality. Even if the object was amended to include functional code, claim 20 fails to tangibly embody the object, so it would still be non-statutory.

12. With respect to claims 21 and 22, the claimed invention is directed to non-statutory subject matter. The claims recite "...the program for causing a computer to perform" which is essentially software per se.

Additionally, claim 22 recites "transmission means" which is not limited to tangible embodiments, and as such the claim is not limited to statutory subject matter and is therefore non-statutory.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miles et al. (U.S. 6,102,406) in view of Kay (WO 00/41067).

Miles teaches the invention substantially as claimed including a new advertising model requiring a user to traverse through an authorized path including at least one predetermined web address (See Abstract, and col. 2, lines 5-10).

15. With respect to claim 1, Miles teaches a user guidance method performed on a computer comprising the steps of:

Incorporating an object into a specific web site at a specific location, where the object is capable of being selected by a user (Miles, col. 10, lines 45-49) in order to provide a reward for the user (Miles, col. 11, lines 1-5); where at least one user desiring to select the object is guided to predetermined content available at the specific web site (Miles, col. 3, lines 35-38).

Miles does not explicitly teach moving the object.

However, Kay teaches an object that appears on a web site that can be selected and takes the user from the specific location to a different location (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

16. With respect to claim 2, Miles teaches the invention described in claim 1, including the user guidance method where the step of moving the object comprises the step of:

Incorporating the object into the specific web site at the different location, after the object has been selected by the user (Miles, col. 10, line 64-col. 11, line 1).

17. With respect to claim 3, Miles teaches the invention described in claim 1, including the user guidance method further comprising the step of:

Providing information, after incorporating the object, concerning the location of the object for the at least one user desiring to select the object (Miles, col. 10, lines 5-8).

18. With respect to claim 4, Miles teaches the invention described in claim 1, including the user guidance method where at the step of moving the object, the user is moved along a predetermined route, and the at least one user desiring to select the object is guided to predetermined content in accordance with a specific order based on the route (Miles, col. 4, lines 48-57).

Miles does not explicitly teach moving the object.

However, Kay teaches an object that is moved (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

19. With respect to claim 5, Miles teaches the invention described in claim 1, including the user guidance method where at the step of incorporating the object, the object is incorporated at specific locations at multiple connected web sites across a network (Miles, col. 3, lines 26-31).

Miles does not explicitly teach moving the object.

However, Kay teaches where at the step of moving the object, the object is moved across the network (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

20. With respect to claim 6, Miles teaches the invention described in claim 5, including the user guidance method where at the user is moved along a predetermined route across the multiple web sites on the network (Miles, col. 4, lines 48-57), and the at least one user desiring to select the object is guided to predetermined content available in a specific sequential order based on the route (Miles, col. 4, lines 48-57).

Miles does not explicitly teach moving the object.

However, Kay teaches where at the step of moving the object, the object is moved across multiple web sites on the network (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

21. With respect to claim 7, Miles teaches a computer-based content advertisement method comprising the steps of:

Incorporating an object into a network among content multiple users desire to browse, where the object is capable of being selected by a user (Miles, col. 10, lines 45-49) in order to provide a reward for the user (Miles, col. 11, lines 1-5), and when a predetermined user browses the content, where a user desiring to select the object, is guided to and enabled to browse the content and additional content (Miles, col. 10, lines 24-27).

Miles does not explicitly teach moving the object.

However, Kay teaches moving the object in the network among additional content multiple users desire to browse (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

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22. With respect to claim 8, Miles teaches the invention described in claim 7, including the content advertising method (Miles, col. 1, lines 43-45) where incorporating an object into a network among content multiple users desire to browse, where the object is capable of being selected by a user (Miles, col. 10, lines 45-49).

Miles does not explicitly teach moving the object.

However, Kay teaches where at the step of moving the object, movement of the object is effected along a route that includes the content multiple users desire to browse (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

23. With respect to claim 9, Miles teaches a computer-based user guidance system comprising:

A server comprising: an object manager for managing the location and movement of an object on a network (Miles, col. 13, lines 36-46); a position information generator for generating information concerning the location of the object, and for providing the information to a user who is accessing the network (Miles, col. 10, lines 5-8); and a processor for, when the object is selected by a predetermined user (Miles, col. 11, lines 1-5), performing a predetermined process associated with the object selection, where the object

manager arranges the object at a desired location in order to guide the user to desired content on the network (Miles, col. 10, lines 14-49).

24. With respect to claim 10, Miles teaches the invention described in claim 9, including the user guidance system where, when the object is selected, the processor transmits a notification to that effect to the object manager, and upon the receipt of the notification (Miles, col. 10, line 64 – col. 11, line 1).

Miles does not teach deletion and repositioning of another object.

However, Kay teaches the object manager deletes the object selected by the user, and positions another object at a different location on the network (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

25. With respect to claim 11, Miles teaches the invention described in claim 9, including the user guidance system where, when the object is selected by a specific user, the processor transmits, together with information concerning the specific user, a notification to that effect to the object manager; where, upon the receipt of the notification, the object manager manages the information concerning the specific user, who is regarded as the person who has selected the object (Miles, Fig. 5, element 32; col. 10, line 64 – col. 11, line 1); where, if the

object is selected by multiple users, only the specific user is regarded as the person who has selected the object (Miles, col. 12, lines 30-35).

26. With respect to claim 12, Miles teaches a computer-based object control system comprising:

Web servers, for storing web pages (Miles, Fig. 3, element 26); and a main server, for communicating with a predetermined web server (Miles, Fig. 3, element 20).

Miles does not explicitly teach moving the object.

However, Kay teaches where the main server incorporates a specific object into a first specific web page and removes the specific object from a second specific web page stored in the specific web server (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

27. With respect to claim 13, Miles teaches the invention described in claim 12, including the object control system where the object is selected when the object is present in a web page that a user is currently browsing (Miles, col. 10, lines 45-49); and where, when the object is selected by the user (Miles, col. 11, lines 1-5).

Miles does not teach deletion and repositioning of another object.

However, Kay teaches the main server deletes the object from the web page and incorporates the object into another web page (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

28. With respect to claim 14, Miles teaches the invention described in claim 12, including the object control system where the main server provides, for the user who accesses the specific web server, information concerning the location of the object that is appearing (Miles, col. 10, lines 5-8).

29. With respect to claim 15, Miles teaches the invention described in claim 14, including the object control system where the information concerning the location of the object, which is provided for the user, indicates the ease with which the object can be reached from the web page browsed by the user (Miles, col. 15, lines 59-61).

30. With respect to claim 16, Miles teaches an object control system of a computer comprising:

An object management means for managing the location of the object on the network, where the object management means changes the location of the object on the network in order to move the object across the network (Miles, col. 13, lines 36-46).

Miles does not explicitly teach embedding the object into a web page.

However, Kay teaches an object to be embedded in a web page stored at a web site on a network (Kay, page 4, lines 22-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable embedding the object into a web page. One would be motivated to do so in order to facilitate promoting purchases from an Internet web site.

31. With respect to claim 17, Miles teaches the invention described in claim 16, including the object control system where the object management means correlates the location of the object with a web page browsed by a predetermined user, and changes the location of the object when web pages are browsed by the predetermined user (Miles, Fig. 5, element 32; col. 10, line 64 – col. 11, line 1).

32. With respect to claim 18, Miles teaches a computer-based object control system comprising:

An object stored in a predetermined server (Miles, Fig. 5, element 36); and object position management means, for determining a web page for setting a link thereto, where, under the control of the object position management means the link setting means changes a target web page for setting a link thereto (Miles, col. 13, lines 36-46).

Miles does not explicitly teach moving the object.

However, Kay teaches link setting means, for setting a link in a web page stored at a web site on the network in order to move to the object (Kay, page 3, line 25 – page 4, line 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

33. With respect to claim 19, Miles teaches the invention described in claim 18, including the object control system where the object position management means defines a web page browsed by a predetermined user as the target web page to which the link with the object is to be set, and changes the target web page as the predetermined user browses the web pages; and where the link setting means, under the control of the object position management means, changes the link with the object (Miles, col. 10, line 45 – col. 11, line 1).

34. With respect to claim 20, Miles teaches an object whose location on the network is managed by specific management means, and which moves from a predetermined web page to another web page, where the object is capable of being selected by a user (Miles, col. 10, line 45 – col. 11, line 1) in order to provide a reward for the user (Miles, col. 11, lines 1-5).

Miles does not explicitly teach moving the object.

However, Kay teaches a moving object (Kay, page 3, line 25 – page 4, line 18), to be embedded in a web page stored at a web site on a network (Kay, page 4, lines 22-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

35. With respect to claim 21, Miles teaches a storage medium on which input means of a computer stores a program in an input-enabled form, the program causing the computer to perform:

A process for incorporating a specific object into a specific web page stored in a specific web server; a process for, when a user browses the specific web page and selects the specific object (Miles, col. 10, line 64-col. 11, line 1).

Miles does not explicitly teach moving the object.

However, Kay teaches moving the object to another web page (Kay, page 3, line 25 – page 4, line 18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

36. With respect to claim 22, Miles teaches a program transmission apparatus comprising:

Storage means for storing a program that causes a computer to perform: a process for incorporating a specific object into a specific web page stored in a specific web server, a

process for, when a user browses the specific web page and selects the specific object and transmission means for reading the program from the storage means and for transmitting the program (Miles, col. 10, line 64-col. 11, line 1).

Miles does not explicitly teach moving the object.

However, Kay teaches moving the object to another web page (Kay, page 3, line 25 – page 4, line 18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miles in view of Kay in order to enable movement of the object. One would be motivated to do so in order to advertise a product or service to a potential customer through a web browser.

Response to Arguments

37. Applicant's arguments filed 14 June 2005 have been fully considered, but they are not persuasive for the reasons set forth below.
38. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

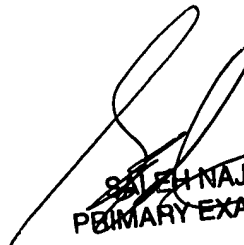
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Baturay whose telephone number is (571) 272-3981. The examiner can normally be reached at 7:30am - 5pm, Monday - Thursday, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alicia Baturay
September 13, 2005


SALEH NAJJAR
PRIMARY EXAMINER